

REMARKS AND ARGUMENTS

I. STATUS OF THE APPLICATION

A. The Office Action Cannot Properly Designated as “Final”

The applicant respectfully requests withdrawal of the finality of the Office Action mailed June 26, 2008. No claims were amended in the applicant’s previous response (mailed February 29, 2008), but this Office Action enters new grounds for rejection. As an example, this Office Action for the first time rejects claim 1 based on a combination of Published U.S. Patent Application No. 2005/0096059 (“Jiang”), Published U.S. Patent Application No. 2004/0105436 (“Ament”) and U.S. Patent No. 6,606,502 (“Chung Kam Chung”). Moreover, this Office Action was entered in response to the applicant’s arguments that certain “claim limitations ... were not addressed in the [previous] Final Office Action.” *See* Pre-Brief Conference Request (Sept. 21, 2007). If those claim limitations are addressed here, then this Office Action necessarily includes new grounds of rejection. Consequently, the finality of the rejection should be withdrawn:

Under present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP § 706.07(a) (emphasis added). *See also* § 706.07(d) (authorizing withdrawal of premature final rejection).

B. Several Claim Limitations Have Not Yet Been Examined

Limitations of several pending claims were not considered or addressed in the Office Action. Rejections of these claims should be withdrawn. In particular substantive examination of claims 15, 23, 28, 30, and 31 is not yet complete.

Claim 15 recites the step of “creating the electronic message only after determining that the expected delay is less than the threshold delay.” That is, instead of creating an electronic message and *then* sending the message if and when the expected delay is low enough, claim 15 requires that the “electronic message” at issue is not even *created* until after the expected delay is low enough. The purported rejection of claim 15 bears no relationship to the language of claim 15. Claim 15 was rejected together with claims 9 and 16 based on the allegation that the prior art “discloses wherein the delay report is sent in response to a delay query from the said subscriber/user.” O.A., p. 7. The terms “delay report” and “delay query” are found in claims 9 and/or 16, but not in claim 15. It is apparent that the substance of claim 15 has not yet been examined.

All independent claims in the application were rejected *en masse*, apparently with the assumption that they are substantively identical. *See* O.A., p. 2-5. At least two examples show this assumption to be incorrect. As a consequence, entire claim limitations have not been considered.

Independent claim 28 recites a system that is operative “to receive from a message sender over the network interface a delay query *including a threshold delay and an electronic message.*” In the collective rejection of the independent claims, the examiner cites no prior art and makes no argument that it would be obvious for a delay query to include 1) “a threshold delay” and 2) “an electronic message.” These limitations

were simply not addressed in the Office Action. Accordingly, substantive examination of claim 28 has not been completed.

These same limitations have gone unexamined in other claims. For example, independent claim 30 recites a method in which the “delay query includ[es] an electronic message,” and dependent claim 31 recites that the “delay query includes the threshold delay.” Nowhere in the Office Action is there any mention of these limitations.

Independent claim 30 was part of an *en masse* rejection with all other independent claims. Likewise, dependent claim 31 was part of an *en masse* rejection with dissimilar claims 8, 11, and 18-20, based only on the allegation that the prior art references “disclose wherein the expected delay has fallen below a threshold delay, wherein the delay report is sent in response to the determination that the expected delay has fallen below the threshold delay.” O.A., p. 6-7. This allegation has nothing to do with whether the delay query itself “includes the threshold delay,” which is the only limitation added by dependent claim 31. The substance of claim 31 has simply not yet been examined.

Independent claim 23, also rejected with the other independent claims, recites the presence of a “subscriber data storage that identifies message senders that subscribe to receive delay reports.” This claim limitation was not addressed in the Office Action.

Thus, in rejecting claims 15, 23, 28, 30, and 31, the examiner failed to consider or address the substance of these claims. The applicant requests withdrawal of the rejections of these claims and consideration of these claims on their merits. The applicant further requests that if any rejections are entered against these claims, that the rejections be properly designated as non-final.

II. SUBSTANTIVE REJECTIONS

A. Prior Art Rejections

All claims pending in the application (1-21, 23, and 25-31) were rejected as being obvious under 35 U.S.C. § 103(a) in light the combination of Published U.S. Patent Application No. 2005/0096059 (“Jiang”), Published U.S. Patent Application No. 2004/0105436 (“Ament”) and U.S. Patent No. 6,606,502 (“Chung Kam Chung”). The applicant traverses these rejections. These rejections presume that Chung Kam Chung discloses the substance following claim elements:

based on the delay report, determining, at the message sender, whether the expected delay is less than a threshold delay; and sending the electronic message to the message gateway only after determining that the expected delay is less than the threshold delay.

(This exemplary language is quoted from claim 1.) Because this presumption is incorrect, the applicant respectfully traverses these rejections. First, the applicant has previously argued that Chung Kam Chung does not disclose these features, and the examiner has *already* agreed with this argument. Second, the Office Action takes two contradictory positions on the disclosure of Chung Kam Chung, neither of which is supported by that disclosure.

1. The Office Action Revives an Interpretation of Chung Kam Chung that the Examiner Previously Agreed was Incorrect

The examiner has already conceded that Chung Kam Chung does not teach the features now relied on in rejecting the claims. In the Office Action mailed October 6, 2006, the examiner previously made the argument that these features *were* taught by Chung Kam Chung, namely that the reference taught:

- determin[ing] whether an expected delay for delivery of an electronic message is less than a threshold. See column 7 lines 54-67.
- sending the electronic message only after determining that the expected delay is less than a threshold. See column 7 lines 54-67.

Office Action (mailed Oct. 6, 2006), p. 7. In response, the applicant pointed out that Chung Kam Chung does not disclose these features, noting, among other points, that

the system of Chung Kam Chung provides that [capacity] information to the message center only after the SMS message has been composed and sent to the mobile switching center and is destined for delivery.

Response (mailed January 8, 2007), p. 10. The applicant reiterated this argument in the Response mailed May 21, 2007. *See, e.g.*, p. 9 (“[N]either the Chung Kam Chung nor the Jiang references relied on disclose that an electronic message can be sent to a message gateway only after determining that the expected delay is sufficiently short.”).

The examiner came to accept that the features at issue are not taught in Chung Kam Chung. The examiner noted in the Office Action mailed November 29, 2007 that “Applicant’s arguments . . . with respect to the rejections(s) of claim(s) 1-31 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.” Page 10. After withdrawing these rejections, the examiner entered new rejections of most claims (namely, claims 1-5, 7, 9-10, 14-17, 23, 28, and 30) that did **not** rely on Chung Kam Chung. *See* p. 2. Now that the applicant successfully argued for the withdrawal of **those** rejections, *see* Pre-Brief Appeal Conference Decision (Apr. 17, 2008), the examiner revived this **old** interpretation of Chung Kam Chung that was previously agreed to be incorrect. Because the Office Action provides no explanation for this changing interpretation of Chung Kam Chung, the applicant’s previous arguments against this interpretation—and the examiner’s previous acceptance of these arguments—still apply with equal force, and the rejections should be withdrawn.

2. The Office Action Relies on two Contradictory Interpretations of the Chung Kam Chung Disclosure

With respect to claim 1, the examiner correctly recognizes that “the combination of Jiang et al. and Ament fails to clearly disclose” two of the features of claim 1. See Office Action (O.A.), p. 4. Namely, the examiner agrees that the following features are not found in a combination of Jiang and Ament:

based on the delay report, determining, at the message sender, whether the expected delay is less than a threshold delay; and sending the electronic message to the message gateway only after determining that the expected delay is less than the threshold delay.

Claim 1 (paraphrased at O.A., p. 4). To complete the rejection of claim 1, the examiner relies on Chung Kam Chung as disclosing these elements. However, the Office Action states two contradictory positions on the same portion of the Chung Kam Chung reference. In particular, the examiner’s interpretation of Chung Kam Chung with respect to claim 1 contradicts the examiner’s own interpretation with respect to the rejection of claim 8.

In making the rejection of claim 1, the examiner contends that Chung Kam Chung discloses the claim elements not found in Jiang or Ament:

Chung Kam [C]hung et al. discloses in column 10 lines 39-57 and column 11 lines 1-25 whereby the expected delay is less than a threshold delay, ***therefore transmitting the said messages.***

O.A., p. 4 (emphasis added). That is, Chung Kam Chung is alleged to disclose that the transmission of the claimed ***electronic message*** depends on the expected delay level. But in the rejections of claim 8 and 25, the same feature of Chung Kam Chung is alleged to

disclose that the transmission of the claimed *delay report*—not the transmission of the electronic message—depends on the expected delay level:

Chung Kam [C]hung et al. disclose wherein the expected delay has fallen below a threshold delay, wherein *the delay report is sent* in response to the determination that the expected delay has fallen below the threshold delay. See column 7 lines 59-67 and column 10 lines 36-65.

O.A., p. 6-7 (emphasis added); p. 8. These two interpretations of Chung Kam Chung are mutually contradictory. For one thing, the claimed “electronic message” is sent (if at all) *from* a user of the claimed method, while the claimed “delay report” is sent *to* the user.

Thus, at least one of these interpretations of Chung Kam Chung is incorrect. The applicant respectfully submits that they are *both* incorrect. As the applicant has shown previously, Chung Kam Chung does not “disclose that an electronic message can be sent to a message gateway only after determining that the expected delay is sufficiently short.” See Response (mailed May 21, 2007), p. 9. Whether Chung Kam Chung is interpreted as sending an “electronic message” or as sending a “delay report,” in neither case does this “sending” depend on whether or not an expected delay has fallen below a threshold.

Because neither of these interpretations of Chung Kam Chung is correct, claims 1 and 8, whose rejections depend on these two different interpretations, should be allowed. In any event, if the examiner interprets Chung Kam Chung so as to reject claim 1, the contradictory rejections of claims 8 and 25 cannot stand, and vice versa.

3. The Ament Reference Does not Disclose a “Message Gateway”

The rejection of all claims relies on the examiner’s contention that the “application (8)” of Ament is a “message gateway” as claimed. O.A., pp. 3-4. The applicant respectfully disagrees and traverses these rejections.

The examiner's interpretation of Ament is self-contradictory, like the interpretation of Chung Kam Chung. According to the examiner, Ament discloses that a message is sent in response to "information from the said resource manager." O.A., p. 3. On one page, the examiner contends that the "application (8)" of Ament *sends* this message, but on the very next page, the examiner implies that the "application (8)" *receives* this message.

In particular, the examiner contends on page 3,

[A]pplication (8) . . . uses the information from the said resource manager in the 'use' phase (15). It is here in the use phase (15), as interpreted by the Examiner, that *the messages are sent* and processed according to the information received from the said resource manager (1).

O.A., p. 3 (emphasis added). But on page 4, the examiner refers to "sending the said electronic message *to a said application (8)*." O.A., p. 4 (emphasis added). Because the application (8) does not send this message to itself, at least one of the examiner's interpretations of the "application (8)" must be wrong.

In fact, the examiner's conflicting interpretations of Ament are both wrong. As to the examiner's 'page 3' interpretation of Ament, this interpretation requires that "the messages are sent" during "the use phase (15)" of the Ament disclosure. But there is no disclosure of messages being sent during this "use phase." Ament's *entire* description of the "use phase" is the following sentence: "Following the request process for the service, the application 8 uses the requested resource during the use phase 15." Par. [0043]. In particular, there is no description of any messages being sent during this "use phase" as a result of "information from the said resource manager," as alleged in the 'page 3' interpretation.

As to the examiner's 'page 4' interpretation, this interpretation implies that messages are being sent "**to** a said application (8)" "based on the delay report received from the resource manager." But in Ament, the only messages disclosed as being sent to the "application (8)" are messages from the "resource manager" itself (e.g., messages 14, 21, 26, 31, 32, 34, 38, 41, 43). Since the resource manager does not send any "delay report" to itself, there can be no message sent to the "application (8)" **based on** a delay report. Thus, the examiner's 'page 4' interpretation is likewise incorrect.

To be fair, the examiner's 'page 4' interpretation can be read in such a way that it does not create a contradiction. However, this reading still requires the claim rejections to be withdrawn. The examiner on page 4 explains,

[T]he combination of Jiang et al. and Ament fails to clearly disclose wherein based on the delay report received from the said resource manager, determining at the said subscriber/user whether the information presented is less than a predetermined threshold delay and if so, sending the said electronic message to a said application (8) only after determining that the expected delay is less than a threshold delay.

O.A., p. 4. This description can be understood to mean that Jiang and Ament teach **neither** "sending the said electronic message to a said application (8)" **nor** "determining that the expected delay is less than a threshold delay." However, if this is the reading intended by the examiner, then the Office Action provides no explanation of how or why the system of Ament would be turned backwards, such that messages as recited in the claims **would** be sent "to a said application (8)." Without any such explanation, there is no *prima facie* case of obviousness, and the rejections of all claims must be withdrawn.

Finally, even if Ament were to teach some of the claimed elements, the Office Action offers no explanation of how or why Ament would be combined with the other references, which are in different technical fields altogether. Ament relates to a "[d]ata

bus system and method,” *see* Abstract, but Jiang and Chung Kam Chung both relate to wireless telecommunications. *See* Jiang, Abstract (“[a] method of wireless communication”); Chung Kam Chung, Abstract (“In a cellular telecommunications network, a method and system. . .”). Thus, even if Ament did disclose a “message gateway,” the Office Action would nevertheless fail to present a *prima facie* case of obviousness. *See* MPEP § 2143.01.

4. No *Prima Facie* Case of Obviousness Has Been Established
Against Any Claim

Like claim 1 discussed above, independent claim 14 requires that messages are sent to a message gateway only after determining that an expected delay is less than a threshold delay. Accordingly, claim 14 is believed to be patentable based on the arguments given above. For these reasons and the other reasons given in this response, no *prima facie* case of obviousness has been established against any of the independent claims 1, 14, 23, 28, and 30, or against their dependents. The applicant respectfully requests withdrawal of the finality of the most recent Office Action and reconsideration and allowance of the pending claims.

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